

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed September 17, 2008. At the time of the Office Action, Claims 13-25 were pending in this Application. Claims 13-25 were rejected. Claims 13 and 20 have been amended to further define various features of Applicants' invention. Claims 14 and 21 have been cancelled without prejudice or disclaimer. Claims 1-12 were previously cancelled without prejudice or disclaimer. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 13-14 and 20-21 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,941,146 issued to Robert Knauerhase et al. ("Knauerhase"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that the cited art as anticipated by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

Applicant submits a new set of claims replacing, without prejudice, the current set of claims. The independent claim 13 includes the subject matter of dependent claim 14 and specifies establishing and permitting a connection to a local wireless network to receive the third party service based on the stored access information. Corresponding amendments have been made to independent claim 20 with the subject matter of dependent claim 21. Basis for these amendments can be found throughout the whole application as filed, especially paragraph [0016]. Thus, no new matter has been added. A marked-up version of the new set of claims is enclosed, from which the Examiner may take the individual amendments made.

The Examiner considers *Knauerhase* to disclose all limitations of the independent claims. Applicants respectfully disagree, because *Knauerhase* does not disclose a fourth item of network information uniquely identifying the local area network, and establishing and permitting a connection to a local wireless network to receive the third party service based on the stored access information.

The Examiner has specifically cited *Knauerhase*, column 3, lines 27-48 to disclose a fourth item of network information uniquely identifying the local area network. Office action, page 4, last paragraph. However, a fair reading of this passage does not disclose such information. Rather, the cited passage relates to the different transceivers a mobile device in *Knauerhase* can have. No information **uniquely identifying** a local area network is mentioned in *Knauerhase*. The Examiner is kindly requested to point out what he interprets to form such information.

As explained in the application, the four items of network information permit a dedicated selection of networks. Such a dedicated selection may be necessary, for example, when a restriction of the access to certain local area networks exists. Application as filed, page 6, paragraph [0016]. Thus, **the four items of network information permit a device to connect to a local area network.**

The Examiner has indicated that *Knauerhase*, column 3, lines 19-26 and column 4, lines 1-57 discloses establishing and permitting a connection to a local wireless network to receive the third party service based on the stored access information. Office action, page 4, lines 13-15. As explained in previous responses, *Knauerhase* discusses coverage maps which can be downloaded from a server, with an indication of what networks are located at a certain position. These maps downloaded on a mobile device do not permit a connection to a local wireless network or not. These maps are merely used as information of networks at a certain position. No information or data in these maps are for authorizing a dedicated connection. This is naturally so, because *Knauerhase* addresses distributing network information, and not authorization of network connections.

Since *Knauerhase* fails to disclose a fourth item of network information uniquely identifying the local area network, and establishing and permitting a connection to a local wireless network to receive the third party service based on the stored access information, it

is respectfully requested that the rejection under 35 U.S.C. §102 is withdrawn. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §102, if necessary.

Rejections under 35 U.S.C. §103

Claims 15-16 and 22-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Knauerhase*.

Claims 17-19 and 24-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Knauerhase* in view of U.S. Patent Application Publication No. 2003/0119481 by Henry Haverinen et al. ("*Haverinen*").

Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog*

Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc., 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

The Examiner has indicated that he considers *Haverinen* to teach the difference mentioned above, namely a fourth item of network information uniquely identifying the local area network, and establishing and permitting a connection to a local wireless network to receive the third party service based on the stored access information. The Applicants respectfully disagree. In *Haverinen*, a mobile station performs PLMN selection on the basis of a **comparison** of the **received PLMN identifiers** PLMN ID and the **PLMN identifiers stored** in the USIM. *Haverinen*, page 4, paragraph [0042], lines 1-4. In other words, both the received PLMN identifiers and stored PLMN identifiers are necessary for the network selection. Contrary hereto, the present invention permits a device to establish a connection to a local wireless network to receive a third party service only based on stored access information.

Since both *Knauerhase* and *Haverinen* fail to teach or suggest a fourth item of network information uniquely identifying the local area network, and establishing and permitting a connection to a local wireless network to receive the third party service based on the stored access information, it is respectfully requested that the rejection under 35 U.S.C. §103(a) is withdrawn. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2545.

Respectfully submitted,
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A handwritten signature in black ink, appearing to read 'A. Grubert', with a stylized flourish at the end.

Andreas Grubert
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Date: December 12, 2008

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